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REMARKS

Claims 22, 25-31 and 34-44 are currently under considered in the subject application. Claims 6-16, 19-21, 23, 24, 32 and 33 have been canceled. Claims 22, 25, 26, 29, 38-40, 43, and 44 have been amended herein. No new matter has been added. Amendments to the claims can be found at pages 2-7.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 22, 26-30, 38, 39 and 43 Under 35 U.S.C. §102(b)

Claims 22, 26-30, 38, 39 and 43 stand rejected under 35 U.S.C. §102(b) as being anticipated by Shepard (US Patent 3,341,711). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Shepard does not teach or suggest the claimed invention.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987)).

As recited in amended claims 22, 26, 38, and 43, the image sensor is one "...that senses a dataform..." Shepard does not teach an image sensor with such capabilities. Moreover, the subject claims are drawn to a data collection device, an assembly thereof, and a scan engine. Shepard does not teach a data collection device, an assembly thereof, and a scan engine. Thus, this rejection should be withdrawn for these independent claims and the claims that depend therefrom.

II. Rejection of Claims 22, 26-31, 36, 38, 39 and 43 Under 35 U.S.C. §102(b)

Claims 22, 26-31, 36, 38, 39 and 43 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ogura *et al.* (US Patent 5,825,560). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Ogura *et al.* does not teach or suggest the claimed invention.

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Ogura *et al.* does not teach each and every element of the subject claims. In amended claims 22, 26, 38, and 43, there is recited, in part, an image sensor "...*contacting an aperture window...*" and "...a prism *mounted on* the aperture window..." Ogura *et al.* neither teaches an image sensor that contacts an aperture window, nor a prism mounted on the aperture window. The aperture of Ogura *et al.* is an opening (Figures 10 and 11; Col. 9, line 60) and not a physical object, as is the aperture window of the subject invention.

In view of at least the above comments, it is respectfully submitted that Ogura *et al.* does not anticipate or render obvious applicant's invention as recited in claims 22, 26-31, 36, 38, 39, and 43, and withdrawal of this rejection is requested.

III. Rejection of Claims 25, 34, 35, 37, 40-42, and 44 Under 35 U.S.C. §103(a)

Claims 25, 34, 35, 37, 40-42, and 44 stand rejected under 35 U.S.C. §103(a) as being obvious over Ogura *et al.* As discussed *supra*, Ogura *et al.* does not teach or suggest independent claims 22, 26, 38 and 43, and this rejection should be withdrawn. Moreover, modifying the system of Ogura *et al.* would render it unsatisfactory for the subject invention. Thus, one of ordinary skill in the art would not have been motivated by its teachings to modify it as suggested in Office Action. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (holding there is no suggestion or motivation to modify the prior art if such modification would render the prior art invention unsatisfactory for its intended purpose).

Nowhere does Ogura *et al.* teach or suggest placement of the image sensor in contact with the aperture window, as recited in the amended claims. Ogura *et al.* consistently illustrates employing a space between the image sensor and a glass member (50, 902) or optical member (G4) in an opening portion (1c, 830, 901) (see Figures 1, 7, 8, 9, 10, 11, 16, 17, 18, 19, 21, and 22). Moreover, it would not have been obvious to do so, since Ogura *et al.* teaches a circuit board or other related mounting structure for use between the image sensor and either the glass member or the optical member.

For at least these reasons, applicant's representative requests that the rejection for these claims be withdrawn.

IV. Rejection of Claim 22 and 43 Under 35 U.S.C. §103(a)

Claims 22 and 43 stand rejected under 35 U.S.C. §103(a) as being obvious over Taniguchi *et*

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al. (US Patent 5,852,287). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Taniguchi *et al.* ('287) does not teach or suggest the claimed invention.

As recited in amended claims 22 and 43, Taniguchi *et al.* neither teaches or suggests an image sensor that contacts an aperture window, nor a prism mounted on the aperture window. Additionally, there is no motivation to modify the system of Taniguchi *et al.* to do so, since that would render the prior art invention unsatisfactory for its intended purpose but further impacting the light to the light receiving element.

Moreover, the prism of the subject invention deflects light from a *first path* entering the prism *to a second path* and into an aperture of the image sensor. Such aspects of applicant's invention as recited in independent claim 43 are not disclosed or suggested by Taniguchi *et al.* ('287). Rather, at Figure 1, Taniguchi *et al.* ('287) illustrates a light beam 17 that travels through the prism 22 onto a photodiode 15 along the *same straight path*, with no deflection from a first path to a second path, as in applicant's claimed invention.

In view of at least the above comments, it is respectfully submitted that Taniguchi *et al.* ('287) does not anticipate or render obvious applicant's invention as recited in claims 22 and 43. Thus, withdrawal of this rejection is requested for these claims, and the claims that depend therefrom.

VI. Rejection of Claim 26, 27 and 36-38 Under 35 U.S.C. § 103(a)

Claims 26, 27, and 36-38 stand rejected under 35 U.S.C. § 103(a) as being obvious over Taniguchi *et al.* ('287) as applied to claim 22 and 43 above, and further in view of Taniguchi (US Patent 5,719,389). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons.

Taniguchi ('389) does not make up for the aforementioned deficiencies of Taniguchi *et al.* ('287) with respect to applicant's claimed invention. Accordingly, the combination of Taniguchi ('389) and Taniguchi *et al.* ('287) does not make obvious applicant's invention as recited in independent claim 26, claims 27, 36, 37 that depend therefrom, and independent claim 38. Withdrawal of this rejection is respectfully requested.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731